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99630-US-NP

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Kathleen Schirtz**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of Dave Snowden

Group Art Unit: 2625

Application No.: 09/745,927

Examiner: Mark R. Milia

Filed: December 21, 2000

Confirmation No.: 2867

For: PROGRAMMABLE PHYSICAL DOCUMENT

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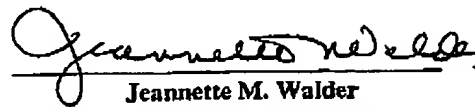
Sir:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES****LETTER**

Enclosed herewith is an Appellants' Brief on Appeal in the above-identified application. An oral hearing is not requested.

Please charge the fee for filing of the Appeal Brief to Xerox Corporation, Deposit Account No. 24-0025.

Respectfully submitted,

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Confirmation No.: 2625

Dave Snowdon et al.

Application No.: 09/745,927

Examiner: Mark R. Milia

Filed: 12/21/2000

Docket No.: 99630-US-NP

For: Programmable Physical Document

BRIEF ON APPEAL

Appeal from Group 2867

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1. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Xerox Corporation, by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 11409, Frame 951-953.

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II. STATEMENT OF RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellants, Appellants' representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

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III. STATUS OF CLAIMS

Claims 1, 3-6, 10, 11 and 13-20 are on appeal.

Claims 1, 3-6, 10, 11 and 13-20 are pending.

Claims 1, 3-6, 10, 11 and 13-20 are rejected.

Claims 2, 7-9, 12 and 21 are canceled.

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IV. STATUS OF AMENDMENTS

No Amendment after Final Rejection has been filed.

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V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention of Claim 1 is directed to a programmable document, comprising: a physical document including at least one sheet of material and information recorded thereon (patent application [hereinafter "pa"] page 3, lines 14-15); and a computer attached to the physical document, wherein the computer includes an input/output device (pa page 3, line 16), a memory storing the recorded information in digital form (pa page 3, line 17), any updates and modifications to the recorded information (pa page 3, lines 20-21), all metadata pertaining to the physical document (pa page 3, line 18), wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information (pa page 10, lines 10-12), a processor (pa page 3, line 17) for updating and modifying the recorded information in digital form and the metadata pertaining to the physical document, and a computer program (pa page 7, line 25), stored in the memory, for implementing defined actions, operable by the processor, wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available.

The invention of Claim 10 is directed to a method for managing, retrieving and processing information about a physical document and modifications to the physical document, comprising: providing a computer, (pa page 6, line 25 and Fig. 2, element 30), wherein the computer includes an input/output device, a processor for updating and modifying information pertaining to the physical document, and a memory (pa page 3, lines 16-17); recording information on at least one sheet of material to generate a physical document (pa page 6, lines 28-29 and Fig. 4, step 44); storing a digital copy of the recorded information (pa page 3, line 17), any updates and

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modifications to the recorded information, and all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information (pa page 10, lines 10-12), in the memory; storing a computer program in the memory (pa page 7, line 25), for implementing defined actions, operable by the processor; associating the stored recorded information and metadata with the physical document; and attaching the computer to the physical document (pa page 4, line 22), wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available (pa page 4, lines 29-30).

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

- 1) Claims 1, 3, 5, 10, 11, 13, 15-17 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrover (US Patent No. 6,585,154) in view of Porter (US Patent No. 6,533,171).
- 2) Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrover (US Patent No. 6,585,154) in view of Porter (US Patent No. 6,533,171) as applied to Claim 1 and further in view of Klotz, Jr. (US Patent No. 5,459,307).
- 3) Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrover (US Patent No. 6,585,154) in view of Porter (US Patent No. 6,533,171) as applied to Claim 1 and further in view of Choksi (US Patent No. 6,477,243).
- 4) Claims 4 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrover (US Patent No. 6,585,154) in view of Porter (US Patent No. 6,533,171) as applied to Claims 1 and 10 and further in view of Friedman (US Patent No. 5,417,508).
- 5) Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrover (US Patent No. 6,585,154).

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VII. ARGUMENT

Appellants' programmable physical document combines the advantages of electronic media with the convenience of paper. Appellants' programmable physical document enables a user to quickly retrieve the electronic version of a document and all associated meta information in any situation where the paper document is available. Appellants' programmable physical document includes a computer program stored in a computer attached to the physical document, which enables the user to store comments about the paper document and modifications to the document in such a way that they could be retrieved and processed electronically, without having to access expensive computer equipment or a network. In Appellants' programmable physical document the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available.

A. Claims 1, 3, 5, 10, 11, 13, 15-17 and 19 are patentable over Ostrover (US Patent No. 6,585,154) in view of Porter (US Patent No. 6,533,171).

1. Neither Ostrover nor Porter is concerned with the problem of storing all transformation information pertaining to the recorded information.

Ostrover is concerned with the problem of producing documents with an electronic copy of at least a portion of the content of the document attached thereto (col. 1, lines 56-58). Ostrover teaches storing an electronic copy of a document in a microchip comprising a memory device and attaching the microchip to a document (col. 1', lines 60-62). The Examiner asserts that since Ostrover teaches that different content can be stored in the microchip in different file formats, that this teaches storing metadata. While some document file formats may include metadata, the mere fact of metadata within a file format does not teach or suggest a programmable document which includes, in part, all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version

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information, user comments, copy information, transformation information, distribution information and index information.

Appellants' programmable document solves the problem of once the electronic document is printed almost all "meta" information (such as the version number, last date of modification, date of printing, change history, comments, authors, reviewer's ratings, etc.) is lost unless such information is explicitly printed on the document. Appellants' programmable physical document solves this problem by storing a record of each transformation, as metadata, in the memory in the attached computer. Each time a physical document is copied and each time a physical document is modified, such as when modifications are written directly on the paper document, all those transformations are stored as metadata in the memory of the attached computer.

Nothing in Ostrover et al. teaches or suggests a programmable document which includes a computer having, in part, a memory storing the recorded information in digital form, any updates and modifications to the recorded information, all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information.

Porter is concerned with the problem of facilitating the exchange of business cards. Porter teaches storing a business card on a smart card, such as an iButton, in order to facilitate exchange via the internet. Porter teaches inserting two SmartCard devices into a reader simultaneously which automatically starts up an application which reads the details (including electronic addresses) from the two cards. The application then emails the business card details of one participant to the email address of the other, and vice versa. See Porter col. 2, lines 23-32.

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Porter does not teach storing all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information on the SmartCard. Porter's system does not contemplate that a record of any transformation of a business card should be stored.

Applicants' programmable document combines the advantages of electronic media with the convenience of paper. Applicants' programmable document enables a user to quickly retrieve the electronic version of a document and all associated meta information in any situation where the paper document is available. Applicants' programmable document stores comments about a paper document and modifications to the document in such a way that they can be retrieved and processed electronically, without having to access expensive computer equipment or a network.

2. Porter teaches away from the use of paper.

Porter teaches eliminating the use of paper business cards. The high rate at which business cards are exchanged can result in a person accumulating an excessive number of cards and to organize the cards into a useful format can be come extremely labor intensive. See Porter col. 1, lines 18-22. Porter teaches storing an electronic copy of a business card so that the paper copy can be destroyed.

3. The combination of Ostrover and Porter does not teach Appellants' invention.

Ostrover teaches attaching an electronic copy of a document in a microchip memory to a hard copy of the document. If one skilled in the art were to combine Ostrover and Porter, one skilled in the art would not get Applicants' invention. At most, the teachings of Porter when

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combined with Ostrover would suggest removing the hard copy of the document since Porter teaches away from the distribution of hard copy business cards.

- B. Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrover (US Patent No. 6,585,154) in view of Porter (US Patent No. 6,533,171) as applied to Claim 1 and further in view of Klotz, Jr. (US Patent No. 5,459,307).

Dependent Claim 6 depends from independent Claim 1. The Examiner cited Klotz, Jr. for disclosing a machine readable label. Nothing in Klotz, Jr. overcomes the lack of teachings in Ostrover and Porter. Since independent Claim 1 is believed to be patentable, Claim 6 is also believed to be patentable.

- C. Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrover (US Patent No. 6,585,154) in view of Porter (US Patent No. 6,533,171) as applied to Claim 1 and further in view of Choksi (US Patent No. 6,477,243).

Dependent Claim 18 depends from independent Claim 1. The Examiner cited Choksi for disclosing a URL of a digital version of the recorded information on the physical document. Nothing in Choksi overcomes the lack of teachings in Ostrover and Porter. Since independent Claim 1 is believed to be patentable, Claim 18 is also believed to be patentable.

- D. Claims 4 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrover (US Patent No. 6,585,154) in view of Porter (US Patent No. 6,533,171) as applied to Claims 1 and 10 and further in view of Friedman (US Patent No. 5,417,508).

Dependent Claims 4 and 14 depend from independent Claims 1 and 10, respectively. The Examiner cited Friedman for disclosing a spiral binding. Nothing in Friedman overcomes the lack of teachings in Ostrover and Porter. Since independent Claims 1 and 10 are believed to be patentable, Claims 4 and 14 are also believed to be patentable.

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E. Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrover (US Patent No. 6,585,154).

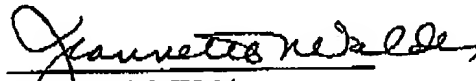
Dependent Claim 20 depends from independent Claim 1. Since independent Claim 1 is believed to be patentable, Claim 20 is also believed to be patentable.

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VIII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that Claims 1, 3-6, 10, 11 and 13-20 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of Claims 1, 3-6, 10, 11 and 13-20.

Respectfully submitted,



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Date: December 22, 2006

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CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1. (Previously Presented) A programmable document, comprising:
a physical document including at least one sheet of material and information recorded thereon; and
a computer attached to the physical document, wherein the computer includes
an input/output device,
a memory storing the recorded information in digital form, any updates and modifications to the recorded information, all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information,
a processor for updating and modifying the recorded information in digital form and the metadata pertaining to the physical document, and
a computer program, stored in the memory, for implementing defined actions, operable by the processor, wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available.
2. (Canceled).
3. (Previously Presented) The programmable document of claim 1, wherein the computer is attached to the physical document by at least one of an adhesive, a removable adhesive, a magnetic material.
4. (Previously Presented) The programmable document of claim 1, wherein the computer is attached to the physical document by at least one of a spiral binding and a reinforced hole with a fastener for holding the computer.

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5. (Original) The programmable document of claim 1, wherein the computer comprises an iButton.

6. (Original) The programmable document of claim 1, wherein the computer has a machine readable label.

7. (Canceled).

8. (Canceled).

9. (Canceled).

10. (Previously Presented) A method for managing, retrieving and processing information about a physical document and modifications to the physical document, comprising:

providing a computer, wherein the computer includes an input/output device, a processor for updating and modifying information pertaining to the physical document, and a memory;

recording information on at least one sheet of material to generate a physical document;

storing a digital copy of the recorded information, any updates and modifications to the recorded information, and all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information, in the memory;

storing a computer program in the memory, for implementing defined actions, operable by the processor;

associating the stored recorded information and metadata with the physical document;
and

attaching the computer to the physical document, wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available.

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11. (Previously Presented) The method of claim 10, further comprising:
performing an activity pertaining to the physical document; and
storing a digital record of the performed activity in the computer.
12. (Canceled).
13. (Original) The method of claim 10, wherein the computer is attached to the physical document by an adhesive.
14. (Original) The method of claim 10, wherein the computer is attached to the physical document by a spiral binding.
15. (Original) The method of claim 11, wherein the activity is selected from the group consisting of copying, providing comments, scanning, referencing an earlier version of the information.
16. (Previously Presented) The programmable document of claim 1, wherein the metadata comprises at least one of an electronic copy of the information recorded on the physical document, comments by readers of the document, state changes and edits made since the document was printed, processing information, version information, copy information, transformation information, distribution information, index information and other miscellaneous information.
17. (Previously Presented) The programmable document of claim 1, wherein the miscellaneous information comprises at least one of a document summary and key words.
18. (Previously Presented) The programmable document of claim 1, further comprising storing a URL for a digital version of the information recorded on the physical document.

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19. (Previously Presented) The programmable document of claim 1, wherein the computer comprises at least one of a smart card, a PCMCIA card, a thin-profile computing device having miniature input/output, processor and memory components disposed on a strip and encased in a durable plastic, miniature input/output, processor and memory components disposed on the physical document and having a strip of clear adhesive placed over them for attaching them to the physical document, and strip and encased in a durable plastic, miniature disposed between two sheets of physical document.

20. (Previously Presented) The programmable document of claim 16, wherein the metadata comprises text, or portions thereof, of the information recorded on the document which has been translated into another language.

21. (Canceled).

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EVIDENCE APPENDIX

NONE

B-1

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RELATED PROCEEDINGS APPENDIX

NONE

C-1